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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

SHIN, KYUNG H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,232	Applicant(s) ARNOLD, GREG ET AL.	
	Examiner Kyung H. Shin	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims **1 - 24** are pending. No claim is amended. Independent Claims are **1, 12 and 21**. This action is **Non-Final** because of a missing issue of the first paragraph of 35 U.S.C. 112.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims **1, 12, 21** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (*see Remarks Page 9, Lines 15-18*).

Response to Arguments

4. Applicant's arguments filed 8/7/06 have been fully considered but they are not persuasive.
 - 4.1 Claims **1, 12, 21** are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material, which is not supported by the prior patent is as follows (refer MPEP 14.22.01):

(see Remarks Page 9, Lines 15-18).

Applicant is required to cancel the new matter in the reply to this Office Action.

There is no disclosure of *"while providing access to other handheld devices or the information"* in the specification or the original claims. This introduces new matter (i.e., matter which is not supported by the disclosure as originally filed), which was introduced by amendment.

After review of the specification and original claims, it was discovered that:

- a) The term, *"other handheld devices"*, does not appear in the specification or the original claims;
- b) The term, *"other handheld device"*, only appears in (paragraph [0005], line 10) and (paragraph [0020], line 20);
- c) The term, *"providing access"*, does not appear in the specification or original claims; and
- d) The phrase, *"while providing access to other handheld devices or the information"*, does not appear in the specification or original claims.

4.2 Applicant argues that in the referenced prior art *"... Hoguta is completely silent as to synchronization ..."*. (see Remarks Page 3, Lines 15-16)

Applicant's invention discloses a file sharing (i.e. file transfer) transaction system in its abstract and specification. Applicant's invention does disclose synchronization in the last 4 lines of the abstract and portions of the specification. File synchronization is the transfer of files between a server and a client to

achieve identical contents within file. Hoguta discloses subscriber information (i.e. profile information for a user or a device), which is utilized to setup an interface for the transfer of information (i.e. file transfer, sharing) between network-connected systems.

- 4.3 Applicant argues that the referenced prior art does not disclose “... *Multer does not teach or fairly suggest modifying an account to identify information ...*”. (see *Remarks Page 7, Lines 18-19*)

It is unclear what Applicant means by the term “fairly suggest”. This statement seems to indicate that the Multer prior art does suggest this action to some degree. The Examiner must assume these actions are taught in the prior art.

- 4.4 Applicant argues that the referenced prior art “... *teach away ...*” (see *Remarks Page 5, Lines 1-3*) ; (see *Remarks Page 5, Lines 15-17*) ; “*fundamental differences between the taught “user” and the recited “device ...*” (see *Remarks Page 4, Line 10*) ; (see *Remarks Page 8, Lines 7-9*)

To teach away, a reference must criticize or discourage a particular embodiment of an invention within a prior art. Multer does not criticize, discredit, or discourage the application of its user information to be utilized for a device. The Applicant Invention's accounting information maintained for the device can be application and application version information. (see *Specification Page 6, Lines 6-8*) The accounting information maintained for the user can be application

and application version information. (see Multer col. 8, lines 40-44; col. The information maintained for Applicant's invention and referenced prior art are equivalent.

Applicant is reminded that, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). (refer MPEP 2145.X.D.1)

There is no disclosure in Multer that discredits, discourages the usage of information on a device basis. If a single user for a single device, the accounting information for that one device is equivalent to Applicant's Invention. A profile is information about a particular entity, whether it is a user or a device. In this situation, there is no fundamental difference between a user or a device. The prior art's treatment of a user is equivalent to the Applicant Invention's treatment of a device.

- 4.5 Applicant argues that the referenced prior art does not disclose " ... *storage of a user's entire file system tree ...* " (see Remarks Page 7, Line 2)

Multer discloses several implementation of a storage server with the storage of an entire file system as only one embodiment or implementation. (see Multer col. 32, lines 65 - col. 33, line 13) It is unclear what relevance this has for Applicant's Invention. Whether an entire file system is stored on a storage server

has no bearing on whether the file system (i.e. a portion of file system) is updated. Updating a set of files (i.e. a complement of files) within the entire file system has no bearing on whether the entire file system is stored on a storage server. A portion of the files can still be updated.

- 4.6 Applicant argues that the referenced prior art does not disclose “ ... *describing a complement of information stored in the second handheld device ...* ” (see *Remarks Page 8, Lines 5-6*)

Multer does disclose this limitation. This complement (i.e. or a set) of information stored on a handheld device based on a unique account. It has been established that a user account is equivalent to a device account, therefore, the accounting information is for a device. (see Multer col. 34, lines 16-19; col. 31, lines 52-62; col. 16, lines 50-50: user accounting information for each user stored on)

In addition, the Multer prior art discloses information that is new to (i.e. first, second, and etc.) handheld device. Information is on remote server and not in handheld device (i.e. new) and can be downloaded at a later time period. (see Multer col. 6, lines 4-12; col. 44, lines 48-54: information resides on server, information downloaded) Multer does disclose

- 4.7 Applicant argues that in the referenced prior art “ ... *Multer does not even utilize the word “token” or similar forms ...* ” (see *Remarks Page 11, Lines 16*)

Multer does disclose this claim limitation. Multer does disclose a similar form, the datapack. It is not a requirement to disclose a token, when the prior art named entity, the datapack, performs an equivalent function. A token is defined as an entity to identify information. A token causes the account to be modified (see Remarks Page 11, Lines 14), and the referenced prior art's datapack causes particular account information and data on the handheld device to be modified. The Multer discloses a data package, which is utilized to identify information. (see Multer col. 10, lines 26-31: data package, change information) The data package is equivalent to the invention token.

- 4.8 Applicant argues that in the referenced prior art “... wherein the information is a version of an application program...” (see Remarks Page 12, Line 18 - Page 13, Line 1)

Multer does disclose this claim limitation. Multer disclose a version number per object. (see Multer col. 12, lines 10-12), and each application has an application object. Multer discloses the processing of application programs, its version information, and the capability to match (i.e. synchronize) applications between systems (i.e. handheld devices). (see Multer col. 12, lines 10-12; col. 15, lines 10-11; col. 15, lines 27-30: application information processed) Multer does disclose versioning

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4.9 The rejection for each independent and dependent claim includes a citation from the referenced prior art that discloses the basis for the rejection. Each obviousness combination clearly indicates the claim limitation the combined reference prior art teaches. In addition, a cited passage from the referenced prior art clearly indicates the motivation for the obviousness combination. Each obviousness combination's disclosure is equivalent to the applicant's claimed invention.

4.10 In conclusion, the examiner has considered the Applicant's remarks concerning the data transfer sharing transactions between network-connected systems. All claims in Applicant's invention have been rejected as anticipatory or obvious based on the referenced prior art.

After the additional analysis of the applicant's invention, remarks, and an additional search of the available prior art, it was determined that the current set of prior art consisting of **Yeung (6,643,702)**, **Bastiani (6,636,922)**, **Takabatake (6,728,244)**, and **Lappetelainen (6,693,915)** discloses the applicant's invention including disclosures in Remarks dated August 7, 2006.

These rejections are set forth in prior Office Action, Paper No.

09863232\20060428 and reproduced for convenient.

Claim Rejections - 35 USC § 103

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5. **Claims 1 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Multer et al.** (US Patent No. 6,757,696) and in view of **Hoguta et al.** (US Patent No. 6,725,303).

Regarding Claim 1, Multer discloses a method of transferring information comprising the steps of:

- a) a first handheld device (see Multer col. 4, lines 27-34: handheld device utilized) causing an account (see Multer col. 32, lines 53-55: account information) to be accessed that is stored on a remote server, the account reserved for a second handheld device and describing a complement of information stored in the second handheld device; (see Multer col. 34, lines 16-19; col. 31, lines 58-62; col. 16, lines 50-50: user accounting information for each user stored on)
- b) the account modified to identify an information that resides on the remote server but not on the second handheld device; (see Multer col. 17, lines 15-20; col. 32, lines 14-17: user accounting information for particular user updated and stored on server)
- c) the second handheld device establishing a connection with the remote server; (see Multer col. 5, lines 10-17; col. 6, lines 16-20: handheld device communications between server and handheld device through connection) and

Multer discloses wherein the remote server automatically determining, from the account, that the information is new to the second handheld device and in response thereto for automatically downloading the information to the second

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handheld device. (see Multer col. 34, lines 23-29: user information updated (i.e. new information)) Multer does specifically disclose the capability to enable access to user profile by another user.

However, Hoguta discloses:

d) wherein while providing access to other handheld devices or the information.

(see Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access profile information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Multer to enable access to profile information by a user of a network capable device as taught by Hoguta. One of ordinary skill in the art would be motivated to employ Hoguta in order to enable uniform customization of services based on profile and preferences information. (see Hoguta col. 1, lines 54-57: “ ... a need for providing a subscriber with a method of uniformly customizing the use of varied terminals and services in accordance with a subscriber's preferences and purchased entitlements ... ”)

Regarding Claim 2, Multer discloses a method as described in Claim 1 further comprising the step of the first handheld sending the remote server a token identifying the information and the second handheld and wherein the token causes the account to be modified by the remote server. (see Multer col. 37, lines 62-65: data pack (i.e. token) used for information transfer utilized for update)

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Regarding Claims 3, 14, Multer discloses a method as described in Claims 1, 12

wherein the first and the second or the sender and the receiver handheld devices are handheld computer systems. (see Multer col. 4, lines 27-36: two devices (i.e. handheld devices) in communication)

Regarding Claims 4, 15, 23, Multer discloses a method as described in Claims 1, 12, 21 wherein the information is a version of an application program. (see Multer col. 12, lines 10-12; col. 12, lines 16-20; col. 13, lines 3-7: version information processed)

Regarding Claims 5, 16, 24, Multer discloses a method as described in Claims 4, 15, 21 wherein the account comprises an application version record table comprising an entry for each application stored in the second handheld device and wherein each entry comprises: an application identifier; a version identifier; and a user identifier. (see Multer col. 38, lines 3-5 col. 38, lines 8-15; col. 38, lines 55-59: identifiers utilized to designate contents within table entries)

Regarding Claim 6, Multer discloses a method as described in Claim 1 wherein the step of automatically downloading the information to the second handheld device, of step d), is performed only if the first handheld device has authority to download to the second handheld device. (see Multer col. 33, lines 13-17; col. 34, lines 23-29; col. 5, lines 17-21: authentication for device based on account information, download information)

Regarding Claims 7, 18, Multer discloses a method as described in Claims 6, 17 wherein the authority is established via an express grant of permission from the second handheld device to the first handheld device. (see Multer col. 34, lines 16-19: authorization for device based on account information)

Regarding Claims 8, 19, Multer discloses a method as described in Claims 6, 17 wherein the authority is established via a user confirmation that is made in response to a user message displayed on a display screen of the second handheld device. (see Multer col. 12, lines 29-36; col. 32, lines 23-28: user interface)

Regarding Claims 9, 20, Multer discloses a method as described in Claims 1, 12 wherein the remote server is a web based server. (see Multer col. 31, lines 21-23: web based (i.e. HTTP) server)

Regarding Claim 10, Multer disclose a method as described in Claim 1 wherein the step d) is performed within a synchronization process between a remote server and the second handheld device. (see Multer col. 7, lines 58-64; col. 14, lines 18-19: synchronization process for information within server and handheld device)

Regarding Claim 11, Multer disclose a method as described in Claim 1 wherein the step d) is performed within a synchronization process between a host computer system

and the second handheld device. (see Multer col. 7, lines 58-64; col. 14, lines 18-19: synchronization process for information in server and two devices (i.e. host system and handheld device))

Regarding Claim 12, Multer discloses a system comprising:

- a) a receiver handheld device; (see Multer col. 4, lines 25-36; col. 5, lines 17-21: receiver system (i.e. handheld device))
- b) a remote server containing an account reserved for the receiver handheld device which describes a complement of information stored in the receiver handheld device; (see Multer col. 17, lines 15-20; col. 32, lines 14-17; col. 16, lines 50-50: server management system for user accounting information)
- c) a sender handheld device for causing the account to be modified to identify an information that resides on the remote server but not on the second handheld device; (see Multer col. 33, lines 13-17: update information within server system)
- d) wherein the receiver handheld device is for establishing a connection with the remote server; (see Multer col. 5, lines 10-17; col. 8, lines 16-19: handheld device communicating through connection between server and handheld device) and

Multer discloses wherein the remote server is for automatically determining, from the account, that the information is new to the receiver handheld device and automatically for downloading the information to the receiver handheld device. (see Multer col. 34, lines 23-29: user information updated (i.e. new information))

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Multer does specifically disclose the capability to enable access to user profile by another user.

However, Hoguta discloses:

- e) wherein while providing access to other handheld device for the information. (see Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access profile information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Multer to enable access to profile information by a user of a network capable device as taught by Hoguta. One of ordinary skill in the art would be motivated to employ Hoguta in order to enable uniform customization of services based on profile and preferences information. (see Hoguta col. 1, lines 54-57)

Regarding Claim 13, Multer discloses a system as described in Claim 12 wherein the sender handheld is for sending the remote server a token identifying both the information and the receiver handheld and wherein the token causes the remote server to modify the account. (see Multer col. 5, lines 17-21; col. 6, lines 16-20; col. 37, lines 62-65: data pack (i.e. token) utilized to modify user information)

Regarding Claim 17, Multer discloses a system as described in Claim 12 wherein the remote server is also for determining if the sender handheld device has authority to download to the receiver handheld device as a precursor to downloading the information to the receiver handheld device. (see Multer col. 4, lines 25-36; col. 6, lines

16-20: authorization for device, download information to device)

Regarding Claim 21, Multer discloses a system comprising:

- a) a receiver handheld computer; (see Multer col. 4, lines 25-36; col. 5, lines 17-21: receiver system (i.e. handheld device))
- b) a web based server containing an account reserved for the receiver handheld computer which describes a complement of information stored in the receiver handheld computer; (see Multer col. 31, lines 21-23: web based (i.e. HTTP) server)
- c) a sender handheld computer for causing the account to be modified to identify an information that resides on the web based server but not on the receiver handheld computer; (see Multer col. 17, lines 15-20: update accounting information managed within management (i.e. web based)server)
- d) wherein the receiver handheld computer is for establishing a connection with the web based server; (see Multer col. 5, lines 10-17; col. 6, lines 16-20: handheld device communicating through connection between server and handheld device) and

Multer discloses wherein the web based server automatically determines, from the account, that the information is new to the receiver handheld computer, also determines if the sender handheld computer has authority to download to the receiver handheld computer, and, if so, automatically downloads the information to the receiver handheld computer. (see Multer col. 34, lines 23-29:

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update user information (i.e. new information)) Multer does specifically disclose the capability to enable access to user profile by another user.

However, Hoguta discloses:

e) wherein while providing access to other handheld devices for the information.

(see Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access profile information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Multer to enable access to profile information by a user of a network capable device as taught by Hoguta. One of ordinary skill in the art would be motivated to employ Hoguta in order to enable uniform customization of services based on profile and preferences information. (see Hoguta col. 1, lines 54-57)

Regarding Claim 22, Multer discloses a system as described in Claim 21 wherein the sender handheld is for sending the remote server a token identifying both the information and the receiver handheld and wherein the token causes the web based server to modify the account. (see Multer col. 17, lines 15-20; col. 37, lines 62-65: data pack (i.e. token) used to manage user accounting information within management server (i.e. remote server))

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KHS
Kyung H Shin
Patent Examiner
Art Unit 2143

KHS
10/28/06


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100